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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/343,728	06/30/1999	TOSHIHISA SAWADA	P18153	8274

7055 7590 07/01/2004

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RESTON, VA 20191

EXAMINER

SAFAIPOUR, HOUSHANG

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 07/01/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/343,728

Applicant(s)

SAWADA, TOSHIHISA

Examiner

Houshang Safaipoor

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's amendment filed on April 8, 2004, has been entered and made of record.

### ***Response to Arguments***

The following is the response to applicant's arguments.

Applicant argues that according to the teachings of the cited reference (Smith et al.), the UN server converts the messages into a proper communication format not a transmitting apparatus as claimed by the applicant. As stated by the applicant the "UN server of Smith et al. sends the converted message to the recipient". Therefore, examiner considers the UN server as a transmitting apparatus. Applicant further argues that the UN server of Smith et al. converts the message into the proper communication format for the recipient, based on recipient information and not in a predetermined format. Examiner adds that the recipient information are stored in their respective profile (col. 4, lines 46-57) and therefore, are predetermined. Applicant further argues that the recipient of Smith et al. does not select data stored in the server. Examiner disagrees. Recipient of Smith et al. selects the time, the day and also the location that certain messages (normal importance or high importance) can be sent (col. 9, lines 14-24).

For the reasons stated, examiner maintains his rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 19, 22, 24 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (U.S. Patent No. 6,463,462).

Regarding claim 19, Smith et al. discloses an image data transmitting apparatus comprising:

a file converter configured to convert image data into a plurality of file formats, the data of each file format including all of the image data; a memory configured to store an e-mail address of recipient and an address of a server corresponding to the e-mail address of the recipient; a transmitter configured to determine the server corresponding to the recipient when e-mail address of the recipient is input, to transmit to the server the data in the plurality of file formats and to transmit to the recipient, by e-mail, the address of the server in which the data in the plurality of file formats corresponding to the image data is stored (abstract, col. 6, lines 41-60 and claims 1 and 9).

Regarding claims 22, 24 and 25-27 arguments analogous to those presented for claim 19 are applicable to claims 22, 24 and 25-27.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 20 is rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (U.S. Patent No. 6,463,462).

Regarding claim 20, plurality types of file formats comprising a JPEG file, a tiff file or a bit map file are well known and routinely utilized in the art (Official Notice). Therefore it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to include this feature in Smith's automated system.

Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (U.S. Patent No. 6,463,462) and in view of Bobo, II. (U.S. Patent No. 5,675,507).

Regarding claim 21, Smith et al. does not explicitly disclose the apparatus according to claim 19, wherein a file converter converts image data in units of a page. Bobo discloses such an apparatus (col. 11, lines 11-23). Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to combine Bobo's apparatus with that of Smith et al., because this addition would enhance the design.

Regarding claim 23, the arguments analogous to those presented for claim 21 are applicable to claim 23.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Contact Information***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipoor whose telephone number is (703)306-4037. The examiner can normally be reached on Mon.-Thurs. from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles, Sr. can be reached on (703)305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Houshang Safaipoor  
Patent Examiner  
Art Unit 2622  
February 17, 2004

  
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